

RESPONSE AND REMARKS

Amendments to Claims 1 through 21 are filed concurrently herewith to more distinctly claim the invention. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested.

SPECIFICATION

In the Office action, the Examiner objected to use of various trademarks as used in the specification and indicated that the trademarks should be capitalized wherever they appear. Responsive to the Examiner's objections to the use of trademarks, the specification, as amended, identifies trademarks used in the specification, references the proprietary nature of those trademarks through the use of the "TM" symbol, and equates the TM-designated trademark with both an all-capitalized version of the trademark and with alternative ways in which the trademarks appear in the specification.

SECTION 112

In the Office Action, the Examiner rejected Claims 1-21 as being indefinite under 35 U.S.C. §112 on several grounds. The Examiner rejected Claims 1-3, 8-10 and 15-17, concluding that there was insufficient antecedent basis for the claimed term "each user client computer device." Amendments to the rejected claims have been made to more specifically recite antecedent basis for the claimed term "user client computer device."

In the Office Action, the Examiner objected to the term "each of a plurality of carriers" in Claims 1, 8, and 15, as indefinite. Amendments to the rejected claims recite "each carrier of a plurality of carriers."

In the Office Action, the Examiner objected to the punctuation of Claims 4, 11, and 18, and suggested alternative punctuation. Amendments to the rejected claims incorporate additional punctuation.

In the Office Action, the Examiner objected to the term "the particular requesting user" and "the particular user" in Claims 2, 3, 6, 7, 9, 10, 13, 14, 16, 17, 20 and 21, as having insufficient antecedent basis. The rejected claims have been amended to provide antecedent basis to support the amended claimed terms.

SECTION 101

In the Office Action, the Examiner rejected Claims 1 through 14 under 35 U.S.C. §101. In rejecting these claims under Section 101, the Examiner read the claims as "not require[ing] the use of the computer system" but as "mere[ly] recit[ing]" . . . "technological arts . . . in the preamble." The Examiner concluded that the preamble of the rejected claims provided a "mere implication of employing a machine or article of manufacture to perform some or all of the recited steps" and that the rejected claims are "directed to non-statutory subject matter."

It is respectfully submitted that because reference in the preamble of each of Claims 1 through 14 to "a . . . computer system" provides antecedent basis for subsequent reference to "*the* computer system" in each of Claims 1 through 14, those claims are properly directed to statutory subject matter under Section 101. In particular, the preamble of each of Claims 1 through 14 recites, or is dependent on a claim that recites, "a . . . computer system"; the body of the rejected claims (or a claim on which the subject claim is dependent) use as antecedent basis, recitation of "a . . . computer system" in the preamble. For example, the preamble of Claim 1 recites "A . . . computer system"; the body of Claim 1 (as amended) recites . . . "wherein each respective user accesses *the* computer system . . . ". (Emphasis added).

It is respectfully submitted that the preamble of a claim, such as the preamble of Claims 1 through 14, that recites matter that breathes life into the claim should not be discounted as a mere recitation of technological arts. See Stranco Inc. v. Atlantes Chemical Systems Inc., 15 U.S.P.Q.2d 1704, 1713 (S.D. Tex. 1990) ("The fact that a preamble is necessary to provide antecedent basis for subsequent language in the claim is significant in determining that the preamble is a claim limitation."); see also, Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997) ("Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. . . ."). In the present case, because the preamble of Claims 1 through 14 provides antecedent basis for subsequent language of the claims, the claim preamble of each respective claim is properly taken into account when interpreting each claim.

Taking the preamble of each respective claim into account, it is respectfully submitted that Claims 1 through 14 are directed to statutory subject matter under 35

U.S.C. §101 because they are expressly directed to a computer system (Claims 1 through 7), or a method using a computer system (Claims 8 through 14).

Further, as the Examiner agrees, Claims 1 through 14 are directed to a practical application in the technological arts, the purpose of which is to produce a real world useful result, namely, e.g., "calculated rates for carriers used in selecting a specific service for shipping . . . ". Office Action, page 5, topic number 15. Therefore, Claims 1 through 14 are directed to statutory subject matter under 35 U.S.C. § 101. See, e.g., State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citations omitted) ("Congress intended §101 to extend to 'anything under the sun that is made by man.'"); *id.* at 1372 ("The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§102, 103 and 112, P.2, n. 2."); MPEP §2106 II, A (the "purpose of this [section 101] requirement is to limit patent protection to inventions that possess a level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept."); *id.* ("[Patent] Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.").

Further, the claims rejected under section 101 have been amended to expressly recite that the claimed computer system comprises at least one computer device.

For the above reasons and authorities, it is respectfully submitted that Claims 1 through 14, as amended, are directed to statutory subject matter under 35 U.S.C. § 101; it is respectfully requested that Claims 1 through 14, as amended, be reconsidered.

SECTION 102

In the Office Action, the Examiner rejected Claims 1-21 under section 102(b) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls").

It is respectfully submitted that the Claims, as amended, are patentably distinct from the cited reference, alone or in combination with any other reference of record. It is

respectfully submitted that Nicholls does not disclose, anticipate, or suggest, alone or in combination with any other reference of record, the amended claims that are directed to carrier-specific shipping location rules regarding each carrier of a plurality of carriers with respect to a respective shipping location for each respective user of a plurality of users wherein the communication to each respective user is provided via a global communications network, such as the Internet. Further, because, as explained below, Nicholls is not directed to multiple users with distinct shipping locations, Nicholls does not disclose, anticipate, or suggest, alone or in combination with any other reference of record, the amended claims that are directed to collecting a respective user-specific default shipping location from each respective user of a plurality of users and storing the respective user-specific default shipping location in a database.

First, Nicholls is not directed to multiple users with distinct shipping locations. Rather, each Nicholls system must be "preprogrammed [with a] set of rules which are reflective of a *given shipper's predefined set of shipping requirements.*" Nicholls, Col. 2, lines 31-34 (emphasis added). See also, Nicholls, Col. 1, lines 59-61 ("... facilitates the process of shipping goods by a shipper having a predefined set of shipping requirements via a carrier having a predefined rate structure." (Emphasis added)); Nicholls at Col. 4, lines 55-60 ("The presently preferred embodiment facilitates the particular Shipper's requirements . . . in one or more client applications. *These client applications may be customized to conform quite closely to a given shipper's operation.*" (Emphasis added)).

As compared to being pre-programmed to reflect a *given shipper's pre-defined set of shipping requirements* as with Nicholls, the claims of the present application are directed to a system, method or computer program product, as the case may be, that is responsive to a *plurality* of users wherein each respective user has a respective shipping location.

As recited, for example, in amended Claim 1, the claimed computer system is programmed to "receive from each respective user of a plurality of users, a respective input of a set of parcel specifications for shipping a respective particular parcel . . .", Further, as recited in amended Claim 1, "each respective user accesses the shipping management computer system over a global communications network using a respective

user client computer device . . ." that is itself "adapted for communication with the global communications network."

As is further recited in amended Claim 1, in response to each respective input, the computer system is programmed to "apply a set of carrier-specific shipping location rules for each carrier of a plurality of carriers to a respective default shipping location associated with the respective user and to the set of parcel specifications input by the respective user."

In order to communicate with each respective user of a plurality of users, the claimed system must be able to: keep track of each respective user's input; and perform the claimed action, which in the case of Claim 1, is to "apply a set of carrier-specific shipping location rules for each carrier of a plurality of carriers . . .", with respect to each respective user's input and, in the case of Claim 1, with respect to a respective default shipping location associated with the respective user. Nicholls simply does not disclose processing more than one shipping location or more than one user.

Further, Nicholls does not disclose, anticipate, or suggest, alone or in combination with any other reference of record, collecting a respective user-specific default shipping location from each respective user of a plurality of users. Rather, as previously noted above, each Nicholls system is "preprogrammed [with a] set of rules which are reflective of a given shipper's predefined set of shipping requirements."

Nicholls, Col. 2, lines 31-34 (emphasis added).

Accordingly, it is respectfully submitted that Nicholls, alone or in combination with any other reference of record, does not disclose, anticipate, or suggest, the subject matter of the amended claims of the present application.

For the foregoing reasons and authorities, because independent Claims 1, 2, 3, 8, 9, 10, 11, 15, 16, 17 and 18 (as amended), are patentable over the cited references, Applicant respectfully submits that dependent Claims 4 through 7, 12 through 14, and 19 through 21, are therefore also patentable over the cited references.

In view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully submits that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance.

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Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

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